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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/560,803 04/28/00 YOUNG

W P04014US1

EXAMINER

022885 HM12/0612
ZARLEY MCKEE THOMTE VOORHEES & SEASE PLC
SUITE 3200
801 GRAND AVENUE
DES MOINES IA 50309-2721

WINKLER, II

ART UNIT

PAPER NUMBER

1648

DATE MAILED:

06/12/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/560,803

Applicant(s)

YOUNG ET AL.

Examiner

Ulrike Winkler, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claims 1-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-10, 14, 26-33 and 35, drawn to a method of increasing recombinant viral titer by inhibiting the presence of a 5' methylated helper virus using 5-aza-2-deoxycytidine, classified in class 435, subclass 235.1.
- II Claim 25, drawn to an infectious viral particle, classified in class 424, subclass 93.6.
- III. Claims 11 and 34, drawn to drawn to a method of increasing recombinant viral titer by insertion of a demethylation fragment in the LTR, classified in class 536, subclass 23.1.
- IV. Claims 12 and 36, drawn to drawn to a method of increasing recombinant viral titer using an immune response selection, classified in class 424, subclass 85.1.
- V. Claims 13 and 37, drawn to drawn to a method of increasing recombinant viral titer using a synthetic viral promoters, classified in class 536, subclass 24.1.
- VI. Claims 15 and 38, drawn to drawn to a method of increasing recombinant viral titer using antisense, classified in class 536, subclass 23.1.
- VII. Claims 16-24, drawn to a nucleotide sequence encoding a helper virus, classified in class 536, subclass 23.72.
- VIII. Claim 39, drawn to drawn to a method of screening for methylation inhibitors, classified in class 514, subclass 49.

Groups II and VII are a compositions and are distinct from groups I, II-VI and VIII which are drawn to methods. Group II is comprises an infectious viral particle, which is made up of

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nucleic acids, lipids and proteins. Group VII comprises a nucleotide sequence encoding a helper virus; and DNA is made up of nucleic acids.

Groups I, III-VI and VIII are drawn to methods and each is distinct from the other because they utilize different starting materials or different methods of inhibiting the methylation of the helper virus. Though there may be overlap between these methodologies in question for groups I, III-VI, the search for one demethylation protocol will not be coextensive with the protocol utilized in the other methods. The method protocols utilize technologies that are distinct such as DNA manipulation of the LTR, immune response selection, producing a synthetic viral promoter and antisense technology. Group VIII is a method for screening inhibitors of methylation, this method uses different steps from the other methods, thereby setting it apart.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ulrike Winkler, Ph.D. whose telephone number is 703-308-8294.

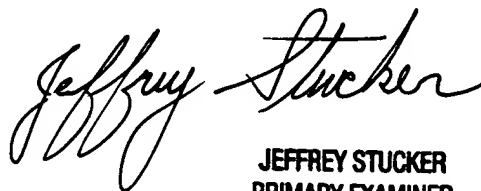
The examiner can normally be reached M-F, 8:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached at 703-308-4027.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 or for informal communications use 703-308-4426.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Ulrike Winkler, Ph.D.


JEFFREY STUCKER
PRIMARY EXAMINER